

Remarks

Applicant would like to thank the Examiner for the courtesies extended to its counsel during the telephonic interviews on March 15, 2005, March 22, 2005 and March 30, 2005. During these interviews, Michael A. Carrillo, attorney for Applicant, and Examiner Daniel Lastra discussed the Chen reference and the claims which are currently pending, including references in each of those documents to using credit cards to track member discounts or rewards. No agreement was reached. In addition, the supervisory examiner in this case, Examiner Eric Stamber, participated in the interview that was conducted on March 30, 2005 with respect to the same subject matter.

Claim 1-23 are pending in this application. Claims 1-23 have been rejected. More particularly, Claims 1-10 have been rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter and Claims 1-23 have been rejected under 35U.S.C. 102(e) as being anticipated by Chen et al., U.S. Patent No. 6,741,969. Applicant makes the following amendments and remarks in response thereto. Since Claims 1-16 have been canceled, the rejections for those claims based on §101 and §102 are moot.

With respect to remaining Claims 17-23, the Examiner has relied on U.S. Patent No. 6,741,969 to Chen (the “969 patent”) to anticipate the steps being claimed therein by Applicant. The subject application was filed on March 8, 2001 and is a continuation of Provisional Application No. 60/221,468, which was filed on July 26, 2000. The ‘969 patent was filed on May 30, 2000 and issued on May 25, 2004. Further, the ‘969 patent is a continuation-in-part of and claims priority to Application Serial No. 09/461,336 (the “336 Application”), which was filed on December 15, 1999. Based on our comparison of the ‘969 Patent and the ‘336 Application, however, it is clear that the disclosure in the ‘969 patent related to using credit cards

to track member discounts, as best exemplified in Figure 10, was added in the continuation application and thus, has a priority date of May 30, 2000. In response to this rejection, therefore, Applicant hereby submits the attached Declaration swearing behind the priority date for the new matter that was added via the continuation-in-part application, i.e., May 30, 2000. Hence, although Applicant disagrees with the Examiner's belief that the '969 patent anticipates the subject application (and most particularly, the remaining claims), it is unnecessary for Applicant to address this since the '969 patent will no longer constitute prior art for the claimed matter in the subject application. In light of the foregoing, Claims 17-23 are not anticipated by the '969 patent and it is respectfully requested that this rejection be withdrawn.

Some minor amendments were also made to Claims 17-19 to more accurately claim the subject invention and to insert language referencing "a credit card" into Claim 18 by amending language from dependent Claim 19 into Claim 18. Since the modifications were either not material changes to the claims or because they were related to elements that were already included in originally filed dependent claims, no additional search should be necessary.

It is believed that the application has complied with all outstanding requirements, and it is requested that this application be given a Notice of Allowability at the earliest possible date. Please contact the undersigned attorney if there are any outstanding issues.

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By: Michael A. Carrillo

Michael A. Carrillo, 44,595
NEAL, GERBER & EISENBERG
Two North LaSalle Street
Chicago, Illinois 60602
(312) 269-8000

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By: Michelle Cook
Michelle Cook

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